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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BASSAM A. SALIBA, KYLE S. YOUNG, MICHAEL L.
WATERSTON, and WARREN T. DENT

Appeal 2009-003851
Application 09/751,436
Technology Center 3600

Decided: April 14, 2010

Before MURRIEL E. CRAWFORD, LANCE LEONARD BARRY, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the rejection of claims 1-59 which have been rejected more than twice. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed to a system and method to conduct financial transactions using e-mail. In the system, a server generates an email message with information including an amount of bill data based at least in part on the email address of the recipient (Spec. 4:12-19). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method comprising:
receiving bill data; and
generating an email message with information including at least a portion of the received bill data, wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient, and wherein the recipient can be either a user or a non-user of a secure email system, wherein no non-user has registered for a service of the secure email system.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Kolling	US 5,963,925	Oct. 5, 1991
McCoy	US 5,649,116	Jul. 15, 1997
Hall	US 5,930,479	Jul. 27, 1999
Slotznick	US 5,983,200	Nov. 9, 1999
Weatherly	US 6,049,784	Apr. 11, 2000
Kahn	US 6,401,079 B1	Jun. 4, 2002
Krishan	US 6,442,539 B1	Aug. 27, 2002
Cornelius	US 6,629,081 B1	Sep. 30, 2003
Ganesan	US 6,678,664 B1	Jan. 13, 2004
Blossman	US 6,721,783 B1	Apr. 13, 2004

Microsoft Computer Dictionary, 1997, Third Edition, pp. 173-174.

Wells Fargo Online, retrieved on May 23, 2004 from www.archive.org link to wells Fargo.com, web pages from Dec. 2, 1998 to Oct. 1, 1998.

The following rejections are before us for review¹:

1. Claims 1-2, 8-19, 25, 28, 36-37, 39-40, 43, 49, and 52 are rejected under 35 U.S.C. § 102(e) as unpatentable over Kolling.
2. Claim 3-6 and 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling and Kahn.

¹ We note that the Examiners Answer does not include the rejection of claims 1, 11, and 37 which was made under 35 U.S.C. § 112, second paragraph, in the rejection of March 26, 2007. Accordingly this rejection is considered to have been withdrawn by the Examiner.

3. Claim 4-6 and 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling and Brossman.
4. Claim 7 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling, Kahn, and Cornelius.
5. Claims 26-27, 38, 50-51, and 59 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling, and Cornelius.
6. Claims 29, 31, 53, and 55 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling and Ganesan.
7. Claim 32 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling, Ganesan, and Blossman.
8. Claim 30 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling, Ganesan, and McCoy.
9. Claim 54 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling and McCoy.
10. Claims 22-23, 46, and 47 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling and Weatherly.
11. Claims 24 and 48 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling, Weatherly, and Kahn.
12. Claims 20-21 and 44-45 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling and Slotznick.
13. Claims 33, 41, and 56 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling and Kahn.
14. Claims 34 and 57 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling, Kahn, and Wells Fargo.
15. Claims 35 and 58 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling, Kahn, Wells Fargo, and Krishan.

16. Claim 42 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kolling, Kahn, and Krishan.

THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making those rejections for which the Appellants have provided arguments for.

With regards to claim 1 and its dependent claims, this issue turns on whether Kolling discloses the claim limitation for “the amount of bill data included in the e-mail message is based, at least in part, on an email address of a recipient”.

With regard to claims 11 and 37 and their dependent claims, this issue turns on whether Kolling and the prior art disclose use for a “non-user” or “non-participant” as claimed.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Kolling has disclosed an electronic statement presentment system (Title). A customer financial institution associated with each statement generation workstation delivers an electronic statement to the appropriate customer using a customer identifier in the statement data and uses any chosen medium (Abstract).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Kolling at Col. 19:26-28 discloses that the summary section of an electronic statement could include an electronic address for customer access to detailed transaction records.

FF3. Kolling at Col. 19:26-28 does not disclose the amount of bill data included in the e-mail message is based, at least in part, on an email address of a recipient.

FF4. Kolling at Col. 5:9-16 discloses that unlike the prior art where customers might choose any multitude of service providers, forcing billers to establish relationships with this multitude of service providers, the system allows a biller to enroll in single electronic statement presentment (ESP) system and be assured that electronic statements will be delivered to its customers, regardless of the customers choice of financial institution

FF5. Kolling at Col. 5:42-58 discloses that the financial institution may use any variety of means to transmit the electronic statement including the Internet, telephones, televisions, or other proprietary communication systems. The consumer financial institution could even print and deliver the statements if wished.

PRINCIPLES OF LAW

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art” *id.* at 415-16.

ANALYSIS

Rejection of Claims 1-2, 8-19, 25, 28, 36-37, 39-40, 43, and 52 under 35 U.S.C. § 102(e) as unpatentable over Kolling

The Appellants argue that the rejection of claim 1 is improper because Kolling does not teach the claim limitation for “the amount of bill data included in the e-mail message is based, at least in part, on an email address of a recipient” (Br. 21) and provides similar arguments in the Reply Brief at 2-3. The Appellants argue that “there is no mention whatsoever of a

relationship between an email address an amount of billing data in Kolling” (Br. 21).

In contrast the Examiner has determined that Kolling discloses the cited claim limitation at Col. 19:26-28 (Ans. 4).

We agree with the Appellants. Kolling at Col. 19:26-28 discloses that the summary section of an electronic statement could include an electronic address for customer access to detailed transaction records (FF2). Kollings citation to “an electronic address” is not disclosed as being the “e-mail address of the recipient”. Kolling thus at Col. 19:26-28 does not disclose “the amount of bill data included in the e-mail message is based, at least in part, on an email address of a recipient” (FF3) as the claim 1 requires. For these reasons the rejection of claim 1, and dependent claims 2 and 8-10, under 35 U.S.C. § 102(e) as unpatentable over Kolling is not sustained.

The Appellants argue that the rejection of claim 11 is improper because it fails disclose use for a “non-user” (Br. 23) and refers to similar argument provided for claim 1 which were made in the Brief at pages 17-20. The Examiner has determined that Kolling discloses such a feature at Col. 5:12-16 (Ans. 7-8).

We agree with the Examiner. Claim 11 includes a limitation for a “financial transaction manager....to effect financial transactions”. The “financial transaction manager” effects “any network participant or non-participant”. Kolling at Col. 5:9-16 discloses that unlike the prior art where customers might choose any multitude of service providers, forcing billers to establish relationships with this multitude of service providers, the system allows a biller to enroll in single electronic statement presentment (ESP) system and be assured that electronic statements will be delivered to its

customers, regardless of the customers choice of financial institution (FF4). Thus, since the billers may enroll in a single ESP system they may be considered “non-participants” with the multitude of service providers which they are not forced to establish relationships with. For these reasons the rejection of claim 11 and its dependent claims under 35 U.S.C. § 102(e) is sustained. The Appellants have provided essentially these same arguments for claim 37, and the rejection of claim 37 and its dependent claims under 35 U.S.C. § 102(e) is sustained for these same reasons. With regard to claim 37, a statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. 41.37(o)(1) 2008.

Rejection of claims made under 35 U.S.C. § 103(a)

The rejections of the dependent claims 3-7 and 9 made under 35 U.S.C. § 103(a) with Kolling and the other cited references is not sustained for the same reasons given above with regard to claim 1 since these claims depend from claim 1.

The Appellants have provided no arguments for the remaining claims rejected under 35 U.S.C. § 103(a). The rejection of these claims is summarily affirmed as the Appellants have provided no arguments for these rejected claims. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-2 and 8-10 under 35 U.S.C. § 102(e) as unpatentable over Kolling.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 11-19, 25, 28, 36-37, 39-40, 43, 49, and 52 under 35 U.S.C. § 102(e) as unpatentable over Kolling.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 3-6 and 9 under 35 U.S.C. § 103(a) as unpatentable over Kolling and Kahn.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 4-6 and 9 under 35 U.S.C. § 103(a) as unpatentable over Kolling and Kahn.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 4-6 and 9 under 35 U.S.C. § 103(a) as unpatentable over Kolling and Brossman.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) as unpatentable over Kolling, Kahn, and Cornelius.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 26-27, 38, 50-51, and 59 under 35 U.S.C. § 103(a) as unpatentable over Kolling, and Cornelius.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 29, 31, 53, and 55 under 35 U.S.C. § 103(a) as unpatentable over Kolling and Ganesan.

We conclude that Appellants have not shown that the Examiner erred in rejecting claim 32 under 35 U.S.C. § 103(a) as unpatentable over Kolling, Ganesan, and Blossman.

We conclude that Appellants have not shown that the Examiner erred in rejecting claim 30 under 35 U.S.C. § 103(a) as unpatentable over Kolling, Ganesan, and McCoy.

We conclude that Appellants have not shown that the Examiner erred in rejecting claim 54 under 35 U.S.C. § 103(a) as unpatentable over Kolling and McCoy.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 22-23, 46, and 47 under 35 U.S.C. § 103(a) as unpatentable over Kolling and Weatherly.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 24 and 48 under 35 U.S.C. § 103(a) as unpatentable over Kolling, Weatherly, and Kahn.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 20-21 and 44-45 under 35 U.S.C. § 103(a) as unpatentable over Kolling and Slotznick.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 33, 41, and 56 under 35 U.S.C. § 103(a) as unpatentable over Kolling and Kahn.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 34 and 57 under 35 U.S.C. § 103(a) as unpatentable over Kolling, Kahn, and Wells Fargo.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 35 and 58 under 35 U.S.C. § 103(a) as unpatentable over Kolling, Kahn, Wells Fargo, and Krishan.

We conclude that Appellants have not shown that the Examiner erred in rejecting claim 42 under 35 U.S.C. § 103(a) as unpatentable over Kolling, Kahn, and Krishan.

DECISION

The Examiner's rejection of claims 1-10 is reversed. The Examiner's rejection of claims 11-58 is sustained.

AFFIRMED-IN-PART

MP

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